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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,081	04/12/2000	Florencio Zaragoza Dorwald	5390.200-US	5691

7590

08/26/2002

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EXAMINER

LIU, HONG

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/26/2002 13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/548,081

Applicant(s)
Dorwald et al.

Examiner
Hong Liu

Art Unit
1624

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 16, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-101 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2002 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 68-101 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' analysis of the law is not agreed with. In *Ex Parte Grasselli*, applicants sought to avoid a 35 USC 102(b) anticipation by writing a proviso which excluded the prior art species, which proviso lacked any description. By contrast, in *In re Johnson*, 194 USPQ 187, 196, the fact situation was somewhat different. There, the claims were narrowed to avoid

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material lost in an interference. In *Ex parte Parks*, 30 USPQ2d 1234, 1236, negative limitation to exclude catalysts was added in a reissue application. The Board held that the negative limitation had support because the specification of the application made no mention of a catalyst throughout the discussion “which would cry out of a catalyst if one were used.” Therefore, the originally-filed disclosure would have conveyed to one having ordinary skill in the art that applicants have the possession of the concept of the claimed subject matter. By contrast, no concept of excluding these particular species would have conveyed to one skilled in the art until prior art had been found and applied. Since the fact situation here is the same as *Ex Parte Grasselli*, and different from *In re Johnson* and *Ex parte Parks*, the former, and not the latter will be followed.

Claim Rejections - 35 USC § 102

Claims 68-69, 72, 74-76, 78, 83, 84, 90, 92, 93, and 99-101 are rejected under 35 U.S.C. 102(b) as being anticipated by Arcari et al. (DE 2700012). Compounds such as 5H-Imidazo[4,5-c]pyridine-5-carboximidamide, 1,4,6,7-tetrahydro-N-(1-methylethyl) still anticipates the instant claims.

Rejection to claims under 35 USC 102(b) as being anticipated by Hauck et al. is hereby withdrawn. Applicants have amended the claims to overcome the rejection.

Rejection to claims under 35 USC 102(b) as being anticipated by Yutilov et al. is hereby withdrawn. Applicants have amended the claims to overcome the rejection.

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Rejection to claims under 35 USC 102(b) as being anticipated by Vincent et al. is hereby withdrawn. Applicants have amended the claims to overcome the rejection.

Claim Rejections - 35 USC § 103

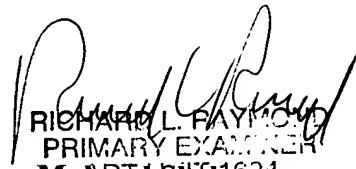
The rejection to claims under 35 U.S.C 103(a) as being unpatentable over Arcari et al. (DE 2700012) is maintained for the same reason given in the above 102 rejection.

Rejection to claims under 35 USC 102(a) as being unpatentable over Scarponi et al. (GB 2158440) is hereby withdrawn. Applicants have amended R3 and R4 to overcome the rejection.

Rejection to claims under 35 USC 102(a) as being unpatentable over Kureha et al. (EP 0589665) is hereby withdrawn. Applicants have amended R3 and R4 to overcome the rejection.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
August 22, 2002


RICHARD L. RAYMOND
PRIMARY EXAMINER
Mukund Shah
Supervisory Patent Examiner
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